**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| In re the Application of (first named inventor): | | Atty. Docket No.: | 011684.00014 |
| **John J. Donahue** | | | |
| Serial No.: | 10/630,905 | Group Art Unit: | 2176 |
| Filed: | July 31, 2003 | Examiner: | Singh, Rachna |
| For: | CREATING AND CUSTOMIZING A WORKFLOW PROCESS FROM A DOCUMENT | Confirmation No.: | 9609 |

**SECOND DECLARATION UNDER 37 C.F.R. § 1.131**

U.S. Patent and Trademark Office
Commissioner for Patents

Sir:

I, John J. Donahue, do hereby declare, that:

1) I am named as the sole inventor of the above-identified patent application;

2) I was and am the owner and President of J. J. Donahue & Company, the assignee of the above-identified patent application, during conception and development of the invention described and claimed in the above-identified patent application;

3) Prior to May 20, 2003, ("the critical date"), I conceived of the invention recited in the pending claims of the above-identified application;

4) Conception is evidenced by the document entitled "Memo," prepared by myself, and attached as Exhibit A. The dates redacted from Exhibit A are prior to the critical date. Other material has also been redacted from Exhibit A, including marginalia and other material not relevant to proving conception of the above-identified application.

5) Evidence of independent claim 1's conception can be found in "Memo" (Exhibit A) at least on page 6 under "Relevant Principles," points 1-3 and on page 3, point 4. Claim 1, as recited, is a claim for a "process for converting a displayed text document into a workflow process" which is found on page 6, point 3, disclosing how to "transform documents into workflow and workflow into documents." Next,

claim 1's three-step process is found, at least, on page 3, point 4. The first step of detecting user selected text and corresponding parameters is inherent in order to perform step 2 of converting it to a data structure. This second step of "converting the user selectable text portions and user-selectable workflow process parameters in step (1) into a data structure representing an ordering of information to be elicited when the workflow process is executed" is explicitly disclosed by this statement on page 3, point 4: "quickly specifying the structure of a particular workflow from the relevant documentation, and at the same time creating an ordination of phases, steps, and questions in a user-friendly format (e.g., users "drill down" from top level phases to lower level steps and questions)." The third step of independent claim 1 is also found in the above cited example of "users 'drill down' from top level phases to lower level steps and questions." Here, it shows one instance of the data structure driving the workflow process.

6) Independent claim 20 recites a "method of reverse engineering a text document into a data structure representing a workflow process" including three steps of: displaying the text document on a computer screen, displaying editing tools superimposed on the document to permit user to tag the document, and generating the data structure representing the workflow process from the tagged document. This claim is disclosed by the "Memo" (Exhibit A) at page 6, under "Relevant Principles" points 1-3. Point 2 explicitly discloses a "reverse engineering methodology" and point 3 discloses utilizing that method with "text tagging" to transform documents into workflow and workflow into documents. The displaying of the document and displaying of editing tools in step 1 and 2, respectively, of claim 20 is inherently necessary to allow a user to perform "text tagging." This is further evidenced in the description of the "express system" on page 3, under "1. Use of Express System:" where it discloses the ability of this system to be edited.

7) Independent claim 27 comprises 6 steps for converting a text document into a workflow process. Again, on page 3, under "4. Reverse Engineering Methodology:" disclosure of "quickly specifying the structure of a particular workflow from the relevant documentation, and at the same time creating an ordination of phases, steps, and questions in a user-friendly format (e.g., users "drill

down" from top level phases to lower level steps and questions)" describes the final three steps explicitly. The first three steps of displaying the document on the computer screen, and detecting user-selected text portions and corresponding associations with the selected text portions are inherently necessary in order for the last 3 steps to occur. Therefore, conception is evidenced by this disclosure.

8) Independent claim 31 is of a system for deconstructing a document into a workflow process including 1) means for detecting user selected text portions of displayed document and detecting user selected work flow process, 2) means for converting the text portions and workflow process parameters into a data structure representing an ordering of information to be elicited, and 3) means for using the data structure to drive the workflow process. "System for deconstructing a document into a workflow process" is found on page 6, point 3 of the "Memo" (Exhibit A), disclosing a system of how to "transform documents into workflow and workflow into documents." Next, claim 31's three-step process is found, at least, on page 3, point 4. The first step of a means for detecting user selected text and corresponding parameters is inherently necessary in order to perform step 2 of converting it to a data structure. This second step of "means for converting the user selectable text portions and user-selectable process parameters into a data structure representing an ordering of information to be elicited when the workflow process is executed" is explicitly disclosed by this statement on page 3, point 4: "quickly specifying the structure of a particular workflow from the relevant documentation, and at the same time creating an ordination of phases, steps, and questions in a user-friendly format (e.g., users "drill down" from top level phases to lower level steps and questions)." The third step of independent claim 31 is a "means for using data structure to drive the workflow process" which is shown by the example of "users 'drill down' from top level phases to lower level steps and questions."

9) Independent claim 33 is a system claim for deconstructing a document into a workflow process. The three steps in this claim are all disclosed in the "Memo" (Exhibit A). Conception of a "document editing tool that permits user to select text portions of the document and to associate with each text portion one or more workflow process parameters that determine a sequence or content of one aspect of

the workflow process" is evidenced generally by the description of the "express system" found on page 3, under the heading "1. Use of Express System:" Here, it discloses that the express system permits fast "editing" of one or more documents on which a business process is built. The second step of "a document generator that converts selected text portions and associated workflow process parameters into a data structure that represents an ordered sequencing of the workflow process" is found on page 3, point 4: "quickly specifying the structure of a particular workflow from the relevant documentation, and at the same time creating an ordination of phases, steps, and questions in a user-friendly format (e.g., users "drill down" from top level phases to lower level steps and questions)." The third requirement of a "secured transactions engine" is disclosed on page 3, under "1. Use of Express Systems" line 7 of the first paragraph of that section, "structured transactions engine" as a description of the workflow system. In the context of the section, a distinction is made between "express" and "workflow" systems where one allows responses from collaborators or counterparties and the other system does not. However, both systems allow the user to answer relevant questions to create the relevant document. See page 2, last paragraph of "2. Use within a Single Organization:"

10) Each of the dependent claims is also disclosed in the "Memo" (Exhibit A) or would be obvious in view of the "Memo."

11) I sent the "Memo" to my patent attorney, Mr. Bradley Wright, prior to the critical date.

12) Prior to the critical date, on May 13, 2003, I had a teleconference with Mr. Wright to discuss various details of my invention. Evidence of the teleconference, in the form of the first page of notes taken by Mr. Wright during the teleconference, is attached as Exhibit B.

13) Subsequent to the date referred to in the preceding paragraph, I continued work on my invention on a regular basis as part of my ordinary course of business. On May 22, 2003, I conducted an online demonstration of a partially operative variant of my invention for Mr. Wright, as evidenced by the email attached as Exhibit C.

14) Subsequent to the date referred to in the preceding paragraph, I continued work on my invention on a regular basis as part of my ordinary course of business. On May 30, 2003, I sent to Mr. Wright, via email, a more fully-featured demonstration of my invention, as evidenced by the email communication attached as Exhibit D. Before the instructions to Mr. Wright on how to launch the demonstration, I described further developments of the method and reiterates some principal steps of the method like "creating and editing a workflow by working on the document that summarizes the relevant decisions." This is found in the first two paragraphs of the email.

15) Subsequent to the date referred to in the preceding paragraph, Mr. Wright prepared and sent to me a draft patent application for my review. On June 23, 2003, I discussed the draft application with Mr. Wright via telephone, as evidenced by the first page of notes taken by Mr. Wright during our teleconference, attached as Exhibit E.

16) Subsequent to the date referred to in the preceding paragraph, I continued work on my invention on a regular basis as part of my ordinary course of business. In addition, I prepared written notes and comments regarding the draft patent application, which I sent to Mr. Wright on June 26, 2003. Evidence of the notes in the form of my email to Mr. Wright is attached as Exhibit F.

17) Subsequent to the date referred to in the preceding paragraph, Mr. Wright continued work on the draft patent application. In addition, I sent an additional email to Mr. Wright on July 1, 2003, with additional information regarding the draft patent application. A copy of the email is attached as Exhibit G.

18) Subsequent to the date referred to in the preceding paragraph, I continued development of my invention on a regular basis as part of my ordinary course of business, including discussing the invention with my technical specialist who assisted with the implementation of my invention. I sent an email to Mr. Wright with comments related thereto on July 7, 2003, a copy of which is attached as Exhibit H.

19) Subsequent to the date referred to in the preceding paragraph, I continued work on my invention on a regular basis as part of my ordinary course of business. From July 9 – 13, 2003, I was preparing for a business trip to Germany, during which I planned on conducting two private meetings to demonstrate a version of my software system that included the potential application of my invention.

20) From July 14 – 17, 2003, I traveled to Germany to conduct two private meetings to demonstrate a version of my software system that included the potential application of my invention.

21) As time permitted while I prepared for and was on the aforementioned business trip, and upon my return through July 24, 2003, I reviewed the patent application to make sure that the document was in order, including the exhibits, and that issues related to the application that had arisen during my travels had been resolved.

22) On July 24, 2003, I sent an email communication to Mr. Wright regarding the draft patent application, a copy of which is attached as Exhibit I.

23) I received a revised draft patent application from Mr. Wright on July 30, 2003, and I returned final comments to Mr. Wright on the same day. A copy of the relevant email string is attached as Exhibit J.

24) Mr. Wright made the final changes to the draft patent application, and sent it to me for final review, along with requisite paperwork to be signed by me prior to filing the application in the United States Patent & Trademark Office.

25) The above-referenced patent application was filed in the USPTO on July 31, 2003.

26) Exhibits A-J and the above statements demonstrate conception prior to the critical date, and diligence from a time at least prior to the critical date up to constructive reduction to practice of the invention(s) of the above-cited application.

27) The attached exhibits have not been altered since they were originally prepared except for the redaction of references to dates, of additional handwritten marginalia, and of other material not relevant to this declaration.

28) I am over 18 years of age and of competent mind.

29) All statements made of my own knowledge are true and all statements made on information and belief are believed to be true; and further, these statements were made with the knowledge that willful, false statement so made are punishable by fine or imprisonment or both, under 18 U.S.C. § 1001 and that such willful, false statements may jeopardize the validity of the above-identified application or any patent issuing thereon.

Respectfully submitted,

John J. Donahue

8/23/06
Date